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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,516	02/06/2002	Gillian Rosemary Bullock	4-30755B	4159

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CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

EXAMINER	
KIM, JENNIFER M	
ART UNIT	**PAPER NUMBER**
1617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/072,516	BULLOCK ET AL.	
	Examiner	Art Unit	
	Jennifer Kim	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-25,27,28,31-36 and 39-41* is/are pending in the application.

4a) Of the above claim(s) *15-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25, 27-28,31-36, 39-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/468,663.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 3, 2007 has been entered.

Action Summary

The rejection of claims 25, 26, 37 and 38 under 35 U.S.C. 102(a) as being anticipated by Wagner et al. (WO 97/49394 A2) of record is hereby expressly withdrawn in view of Applicants' amendment.

The rejection of claims 27-30, 33, 34 and 35 under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (WO 97/49394) of record is being maintained for the reasons stated in the previous Office Action. However, the rejection is modified in this Office Action to exclude cancelled claims and to address newly added claims.

The rejection of claims 31, 32 and 36 under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (WO 97/49394) of record in view of Pool et al. (1998) is

being maintained for the reasons stated in the previous Office Action. The rejection is repeated in this Office Action for Applicants' convenience.

Applicants' amendment necessitated additional rejection presented in this Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28 and 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 28, the phrase "**any one** of claim**s**" renders the claim indefinite, leading to uncertainty regarding whether the claim is depend from multiple claims.

With regard to claims 33-36, the amounts of each of the active ingredients set forth in claims 33-36 render the claims indefinite because they do not fall within the ratio the valsartan to microcrystalline cellulose set forth in claim 25 which they depend from and do not further limit the claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Gasparo et al. (WO 95/24901) in view of Wagner et al. (WO 97/49394) of record.

De Gasparo et al. illustrate a composition comprising valsartan, microcrystalline cellulose, crospovidone and magnesium stearate. (page 6, Example 1). The amount of each of the active agents employed by De Gasparo et al's illustration is within Applicants' amounts set forth in claims 39-41. De Gasparo et al. teach that excipients including silica acid (hydrated silica) can be utilized as a lubricant in the composition. (page 5, lines 7). De Gasparo et al. teach that the composition can be formulated as a unit dose form including tablets. (page 4, 5th full paragraph).

De Gasparo et al. do not expressly teach the tablets are compressed, and the specific amount of silica set forth in claim 41.

Wagner et al. teach that the valsartan tablet prepared by compression methods with silica preferably present in amount of from 0.5 to 10%. (abstract, page 7, 2nd full paragraph, page 14 lines 16-17).

It would have been obvious to one of ordinary skill in the art to modify valsartan formulation of De Gasparo et al to compressed tablet formulation with the specific

amounts of silica taught by Wagner et al. because valsartan can be formulated with silica as an excipient in various oral composition including tablet formulation as taught by De Gasparo et al. and because Wagner et al. teaches the preparation of compressed tablet of valsartan with specific amount of silica. One would have been motivated to make such modification in order to provide various oral dosage forms to meet an individual patients preference. There is a reasonable expectation of successfully formulating compressed tablet formulation of valsartan with the amounts of silica because Wagner et al. teaches the process of making compressed tablets with an excipient such as silica.

Claims 25, 27, 28, 33-35 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (WO 97/49394) of record.

Wagner et al. teach valsartan composition comprising an amount of valsartan more than 35% by weight. (page 2, last paragraph). Wagner et al. teach microcrystalline cellulose is preferably present the composition in an amount of 10 to 30%. (page 7, 2nd full paragraph). This weight percentages of valsartan to microcrystalline cellulose is within Applicant's ratio set forth in claim 25. Wagner et al. teach that crospovidone can be employed in the composition Wagner et al. teach crospovidone as most preferred disintegrant in an amount of from 10 to 20%. (page 7, 2nd full paragraph). This amount also encompasses Applicants' amounts set forth in claims 27 and 28. Wagner et al. teach preferred dosage range of valsartan as 10 to 250mg consists entirely of valsartan, more preferably for example 40, 80 or 160mg, and

the effective amounts can be easily determined by person skilled in the art by routine experimentation and with no undue burden. (page 2, lines 15-22). Wagner et al. teach the binder can be employed as an additive and microcrystalline cellulose is preferred in the dosage form. (page 5, first and last paragraph; page 7, 3rd paragraph, last sentence). Wagner et al. teach the amount of binder may vary within a range of from about 10 to 45% by weight. (page 5, last paragraph, 4th sentence).

Wagner does not expressly teach the specific amounts of microcrystalline cellulose and crospovidone set forth in claims 33, 34 and 35.

It would have been obvious to one of ordinary skill in the art to modify the amounts of microcrystalline cellulose and crospovidone and optimize each of the ingredients therein because Wagner teaches the amounts of the agents to be employed that are encompassing and/or overlapping the amounts and ratios claimed by Applicants. It is noted that Wagner teaches the specific amounts of valsartan to be employed are more preferably for example 40, 80 or 160mg as set forth in Applicants' amounts set forth in claims 33-35. It is noted that Wagner teaches the ranges of microcrystalline cellulose can be range from about 10 to 45%, which overlaps and encompasses Applicants' amounts set forth in claims 30 and 33-35. Wagner further teaches the amounts of crospovidone to be employed from 10 to 20% encompasses/overlapped Applicants' amounts set forth in the claims. One of ordinary skill in the art would have been motivated to optimize the dosage and ratio of agents to be employed in the formulation of Wagner within the dosages of each of the agents taught by Wagner because Wagner teach that amounts to be utilized are easily

determined by person skilled in the art by routine experimentation and with no undue burden and pharmaceutically acceptable as a compressed tablet.

Claims 31, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (WO 97/49394) of record in view of Pool et al. (1998) of record.

Wagner et al. as applied as before.

Wagner et al. do not teach the specific amount (320mg) of valsartan set forth in claims 31, 32 and 36.

Pool et al. teach that the integrated analysis demonstrated a clear increase in blood-pressure-lowering efficacy with increasing dose across the range 10 to 320mg valsartan. The data demonstrate that valsartan provides dose-responsive antihypertensive efficacy across the therapeutic dose range with 10, 20, 40, 80, 160 and 320mg. (abstract).

It would have been obvious to one of ordinary skill in the art to modify the dose of valsartan in Wagner et al.'s formulation to 320mg as taught by Pool et al. because there is clear increase in blood-pressure-lowering efficacy with increasing dose of valsartan as taught by Pool et al. One would have been motivated to increase the dose of valsartan taught by Wagner et al. to 320mg in order to achieve an increased therapeutic effect of lowering blood pressure with higher dosage taught by Pool et al. There is a reasonable expectation of successfully treating hypertension with higher dosage of valsartan than Wagner's amount because Pool et al. demonstrate that there is clear increase in blood pressure lowering efficacy with increased dose of valsartan. With

regard to upper limit of valsartan set forth in claim 31 is obvious within skilled in the art because Wagner teaches the dosage amount of valsartan is easily determined by person skilled in the art by routine experimentation and with no undue burden. One of ordinary skill in the art would have easily determine upper limit or maximum dosage of valsartan to be employed accordance of a patient to be treated based on his medical condition/history.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

None of the claims are allowed.

Response to Arguments

Applicants' arguments filed May 3, 2007 have been fully considered but they are not persuasive. Applicants argue that claims 25 and 28 have been amended such that the formula disclosed in Wagner et al. now fall outside the scope of the amended claims and that the comparative data enclosed in page 5 of Applicants' remark support the argument that a valsartan dosage form with more than 30% by weight MCC surprisingly shows superior bioavailability property over a valsartan dosage form with less than 30% by weight MCC. This is not found persuasive because a valsartan formulation with

more than 30% by weight MCC is well known in view of De Gasparo et al. De Gasparo et al. illustrate a composition comprising valsartan with 110mg of microcrystalline cellulose. The amount of microcrystalline utilized in De Gasparo et al's illustration on page 6, Example 1 is 41% by weight. Applicants' data does not indicate how the amount of MCC (33.75%) of Applicants' formula achieves better bioavailability property compare to the amount of MCC (41%) disclosed in De Gasparo et al. Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Kim
Patent Examiner
Art Unit 1617

Jmk
July 12, 2007